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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,538	03/14/2001	Hideo Ando	204567US2S	2693

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EXAMINER

PATEL, GAUTAM

ART UNIT PAPER NUMBER

2655

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/805,538

Applicant(s)

ANDO ET AL.

Examiner

Gautam R. Patel

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Claims 1-12 are pending for the examination. Claims 1-8 and 11-12 are withdrawn from further consideration.

### Election/Restriction

1. Claims 1-8 and 11-12 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn class other than 369/53.28. Election was made with traverse of claims 9-10.

Applicant's election with traverse of Group D in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "it is believed that the claims pf present application would have to be searched in only a small handful of sub-classes, all of which are in the same class and thus related. ... a search may be made of a large number of, or theoretically all, subclasses without substantial additional effort ..and examination of the entire application would not place a serious burden on the Examiner

This is not found persuasive because, the Examiner does not need to show how big or small subclasses are or how much burden it may or may not put on the Examiner or how search should be done by the Examiner, or how it is commonly done. See 803.00 and 808.01(a); M.P.E.P.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Applicant is reminded that **upon the cancellation of claims to a non-elected invention, the inventorship must be amended** in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship

must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

**The Applicants are urged to cancel non-elected claims 1-8 and 11-12.**

### **Priority**

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

### **Specification**

3. The disclosure is objected for following reasons.

This application does not contain an Abstract of the Disclosure as required by 37 C.F.R. § 1.72(b). An Abstract on a separate sheet is required.

1. Applicant is reminded of the proper language and format of an Abstract of the Disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within **the range of 50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the present application the abstract is too long.

Corrections are required.

### **Claim Rejections - 35 U.S.C. § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 9-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Martynov., US. patent 6,229,600 (hereafter Martynov).

As to claim 9, Martynov discloses the invention as claimed [see Figs. 1-6], An aberration state detection apparatus, including a light sending system, and a detection optical system, comprising:

a light sending system [fig. 6, units 90, 92, 93, 94 and 95] for focusing light from a light source [fig. 6, unit 90] onto a recording surface [fig. 6, surface 87] of an information medium [fig. 6, units 86, 87 and 88];

a detection optical system [fig. 6, unit 105 & 106] for detecting light from said information medium [col. 6, line 22 to col. 7, line 20]; and

means for detecting a state of occurrence of wavefront aberration [fig. 6, unit 107] or spherical aberration of the light focused on the recording surface of said information medium by said light sending system from a detection result obtained by said detection optical system [col. 5, lines 29-54 and col. 7, lines 1-20].

5. as to claim 10, Martynov discloses:

An apparatus comprising a light sending system [fig. 6, units 90, 92, 93, 94 and 95] for focusing light from a light source [fig. 6, unit 90] onto a recording surface [fig. 6, surface 87] of an information medium [fig. 6, units 86, 87 and 88] upon giving an optical aberration to the light, and a detection optical system [fig. 6, unit 105 & 106] for detecting light from said information medium [col. 6, line 22 to col. 7, line 20],

wherein an optical aberration state of the light focused on the recording surface of said information medium by said light sending system is detected from a detection result obtained by said detection optical system [col. 5, lines 29-54 and col. 7, lines 1-20].

#### **Other prior art cited**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Braat et al. (US. patent 5,708,638) "Device for optically scanning a recording medium ..".
- b. Yasuda et al. (US. patent 6,331,455) "Multi-layer optical disc ..".
- c. Hendriks et al. (US. patent 6,192,022) "Focusing a light beam ...".
- d. Ueki (US. patent 6,249,494) "Disk type determining apparatus ...".
- e. Hong (US. patent 5,700,539) "Thin film and interferometric optical disk ..".
- f. Kamatani (US. patent 5,959,280) "Multi-standard optical disk ..".
- g. Hendriks et al. (US. patent 6,567,365) "Optical scanning device".

**Contact Information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read 'Gautam R. Patel', with a long horizontal line extending from the end of the signature.

Gautam R. Patel  
Patent Examiner  
Group Art Unit 2655

September 12, 2003